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IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1945

No. 330

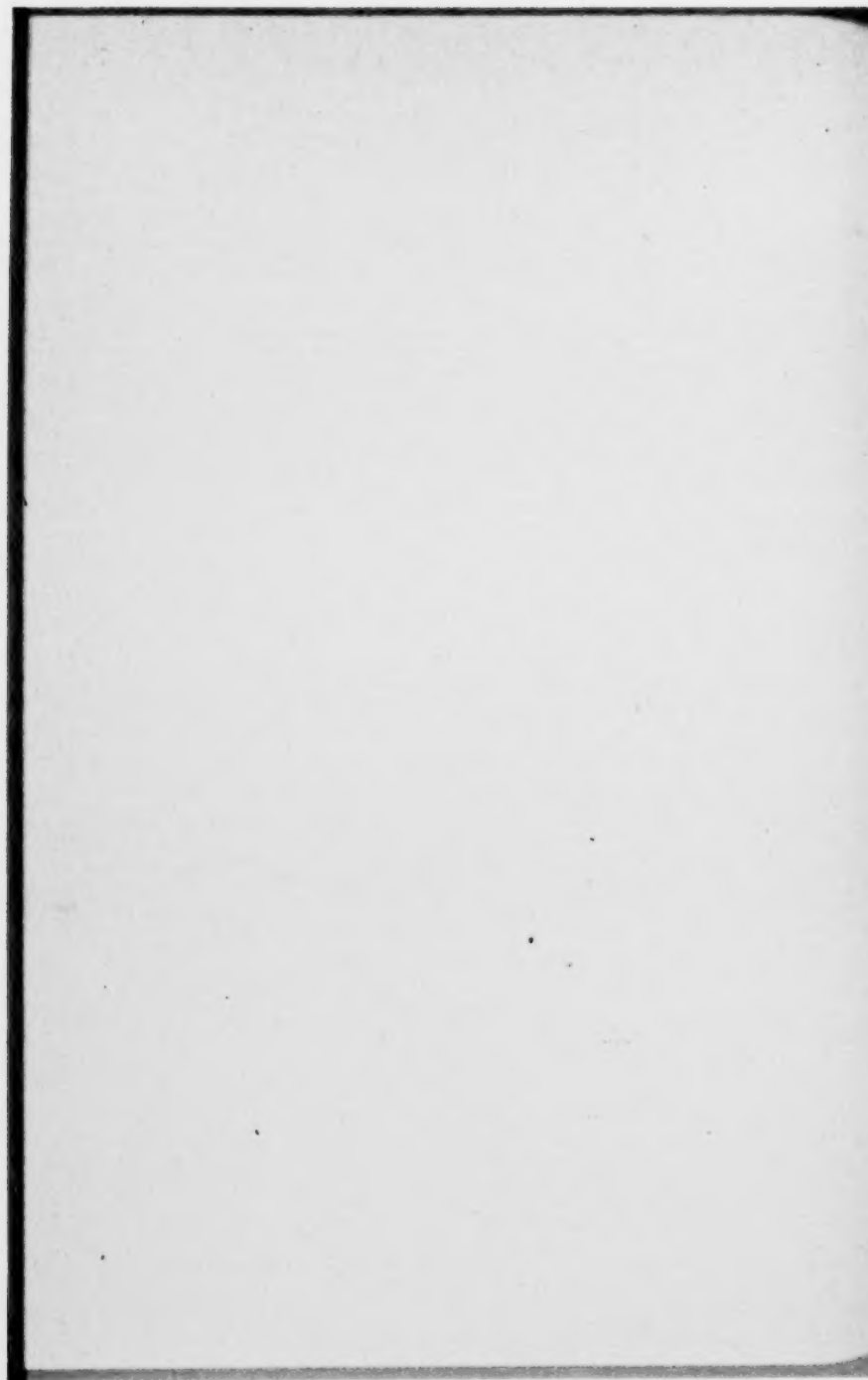
JAMES W. WABER,
Petitioner,
vs.

MONTGOMERY WARD & CO. INCORPORATED, AND
UNITED STATES RUBBER COMPANY,
Respondents.

**REPLY OF PETITIONER TO BRIEF OF
RESPONDENTS IN OPPOSITION TO
PETITION FOR CERTIORARI.**

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*To the Honorable, the Chief Justice and the Associate
Justices of the Supreme Court of the United States:*

The respondents' brief has side-stepped the real issues raised in the petition. Specifically the respondents have not taken issue with and have thereby admitted that Waber has given the art at least **three contributions which are not found in any prior art patent** (Pet. 38).*

First, Waber taught that the base tube must be "slightly smaller" than the cavity of the tire casing; second, that "plastic sealing compound" should be applied to an endless base tube which is used as an air mandrel; and third,

*Pet. as used hereafter refers to the Petition for the Writ of Certiorari and Brief in support thereof; Res. Br. refers to Brief of Respondents in opposition to Petition; and Reply refers to this Reply.

the complete combination of all four steps which are necessary for a successful tube with full details for each step (See Pet. 38).

There is no specific finding by either Court that the above three features are found in any of the prior art. The respondents have offered not a single word asserting that there is evidence in this record that the above features are found in any of the prior art.

Failure to lock horns on these important facts renders the Circuit Court's observation* of anticipation meaningless, for it is an admission by respondents that there is no evidence to support a finding of anticipation. Lacking anticipation, the soundness of the Circuit Court's "could have duplicated" test of invention governs the ultimate disposition of the petition on the merits.

The respondents have woven a superficial argument on the grounds that there are alleged inaccuracies and omissions in the petition (Res. Br. pages 1-4); that a patentee is not entitled to the benefit of the unlikeliness of "a conflict of decisions" rule (Part I, Res. Br. 6-8); that the "could have duplicated" test of invention is sound (Part II, Res. Br. 8-11); that this Court will not consider the alleged anticipation by the Wallace and Wildman patents (Points III and IV, Res. Br. 12-15); that the prior art patents are not abandoned "paper" patents (Part V, Section A, Res. Br. 16-17) and that objective tests of invention are not established by the Courts (Part V, Section B, Res. Br. 17-19).

The Reply follows the order of presentation established in the Respondents' Opposition Brief and demonstrates

*The trial Court did not make a positive finding of anticipation. It stated that the patent "is either anticipated * * * or it fails to disclose invention." (Finding 23, R. 337).

that not a single one of these contentions is supported by the record or by the law.

The allegations of inaccuracy and omissions (Res. Br.1-4) are both unfair and unwarranted. Being unsupported by the record and unrelated to the merits of the controversy, they are a strong admission of weakness by the respondents.

The petitioner's statement that "the Circuit Court of Appeals found only three (of the prior art patents) to be pertinent" (Res. Br. 1) is accurate and consistent with the Court's statement that the three patents were "the most pertinent." The opinion (R. 464-471) mentions not a single prior art patent other than the Wallace, Crombie or Wildman patent. Manifestly, the maxim *expressio unius est exclusio alterius* (25 C. J. pages 220-223; 35 C. J. S. pages 283-284) applies.

The allegation of inaccuracy of the statement that the Court "found that two of the four (Waber) steps were not disclosed in Wallace" (Res. Br. 2) is a result of respondent's failure to distinguish between facts and conclusions. The opinion correctly found, with respect to the base tube, that Wallace "does not explain its relative size and shape" (R. 467). Step (1) of the claim requires a base tube "whose dimensions are slightly smaller than the cavity in the tire casing in which said tube is intended to be used" (R. 466). Thus, the Court found it to be a fact that one step of Waber was not disclosed in Wallace. The Court also found that a "difference between the two processes is the nature of the intermediate layer" (R. 468). Thus, the Court found that a second step (Step 2, R. 466-7) was not disclosed in Wallace. The petitioner's statement of the Court's findings is accurate although it is not consistent with the ultimate conclusion of the Circuit Court of Appeals. In the face of the Court's findings of the foregoing evidentiary facts, its conclusions "Up to this point, the two processes are sub-

stantially, if not precisely, the same" (R. 467); "the only difference" (R. 468); and "Waber's claim to invention over Wallace must rest **solely** on his substitution of a layer of plastic sealing compound for Wallace's layer of puncture-resistant material" (R. 468) are inconsistent with its own fact observations. "Where findings of fact are so inconsistent that it is impossible to harmonize them, it is the duty of the appellate court to accept those which are most favorable to the appellant" (3 Am. Jur. page 463, Appeal and Error, Sec. 898).

That the Court "ignores that the dimensions of the base tube of 'Waber are slightly smaller than the cavity in the tire casing in which said tube is intended to be used'" (Res. Br. 2) is proved by the paragraph above wherein it is shown that the conclusions of the Court disregard the size and shape of the bare tube.

The sophomoric observation of inaccuracy with respect to "*specifically states*" (Res. Br. 2) is based upon respondents' preference for "*specifically quotes*". The distinction is more apparent than real.

The respondents' argument (Res. Br. 2-3) that the Court considered the question of size and concluded that size could not be a feature of the invention necessarily contemplates an unsupported intermediate premise that the "*desired size*" (Res. Br. 3) is "slightly smaller" than the ultimate tire casing (Res. Br. 2; Claim 2, Step (1), Opinion, R. 466). There is no evidence that anyone other than Waber knew or discovered that the "*desired size*" of a base tube of a puncture resistant tube is "slightly smaller" than the ultimate casing. Indeed, the Court did not so find. Thus, the respondents' argument is unsupported by the record or by the opinion of the Circuit Court of Appeals.

That the conclusion of anticipation is based upon the "not entirely clear" language of the Wildman patent and

upon the "assuming" by the Circuit Court of Appeals (Res. Br. 3-4) may not be gainsaid. The language cited by the Court and by the respondents in their brief is a resume of the method of "molding the tube in the way described herein" (Appendix B, Pet. 45). "The way described herein" demonstrates that the Wildman method is not the Waber method (See Appendix B, Pet. 43-45; column 6, Second Method, Appendix A, Pet. 42A). Not only did Wildman contemplate "**in the main**" building on a straight mandrel; but, further, that was the only way he contemplated. There is not one word in the Court's opinion or in the record that Wildman contemplated "forming an **endless** tube of vulcanizable rubber **whose dimensions are slightly smaller than the cavity in the tire casing in which said tube is intended to be used.**" (Step (1), Claim 2, R. 466). Neither the specification nor the opinion of the court indicate that Wildman discloses an **endless** base tube or that he describes **its relative size and shape**. Of course, the language is not entirely clear and the Court was required to rely upon assumption to make out anticipation.

Part I of the respondents' brief (Res. Br. 6-8) argues that the necessary Certiorari requirements are lacking because the rule that unlikelihood of "a conflict of decision resulting from litigation elsewhere" (Res. Br. 6) is applicable only "where the patent was sustained" whereby "the entire industry was subject to domination" (Res. Br. 6-7).

The Court should be as concerned with a patentee who is unable to meet the resulting conflict rule as with an infringer who is unable to do so. The patentee at least, is a law abider, whereas the infringer is a law violator. The Court should be as jealous of an industry which dominates an inventor as it is of an inventor who dominates an industry.

The rule suggested by respondents lacks completely any mutuality or impartiality. The law does not favor one way streets.

At page eight (8), the respondents seek to create the impression that the petitioner seeks a review of facts. This is not so. The "most pertinent" evidence before the Courts below comprised the Wallace, Crombie and Wildman patents. There was no oral testimony of prior uses. The question of anticipation is but a simple matter of comparing the evidence, that is, comparing the disclosures of the documents themselves to determine whether the prior art patents are for the same invention as the Waber patent. This Court does determine for itself by an examination of patent disclosures whether they are for the same or for different inventions. An example (with respect to identity between an original and a reissue patent) is the recent case of *U. S. Industrial Chemicals, Inc. vs. Carbide & Carbon Chemicals Corp.* (1942) 315 U. S. 668, 678. It is a familiar rule of appellate practice that where the evidence is wholly documentary the rule as to the conclusiveness of findings is not strictly applied as it is in cases where the evidence is principally oral testimony (3 Am. Jur. 473, Appeal and Error Sec. 906; 5 C. J. S. 751, Appeal and Error Sec. 1660; 4 C. J. 889, Appeal and Error Sec. 2859). Moreover, oral testimony is inadmissible to enlarge the scope of letters patent. *U. S. Industrial Chemicals, Inc. vs. Carbide & Carbon Chemicals Corp.* (1942) 315 U. S. 668, 678; *Collar Co. vs. Van Dusen* (1874) 23 Wall. (90 U. S.) 530, 557; *Corning vs. Burden* (1853) 15 How. (56 U. S.) 252, 270.

Respondents' statement that "the lower Courts' findings herein are concurrent" (Res. Br. 8) is inaccurate as is shown by the following:

With respect to the Wallace patent, the Trial Court's opinion was that Wallace was "in point" (R. 331) although

its finding of fact, prepared by respondents, recites that Wallace discloses **"everything"** of Waber except the substitution of the intermediate layer (Finding 20, R. 337). The Circuit Court of Appeals on the contrary found that Wallace did not explain the **"relative size and shape"** of the base tube (R. 467). Thus with respect to Wallace, the findings are not concurrent; indeed, they are opposite.

With respect to Crombie, the apparent concurrence (Trial Court Finding 19, R. 336; Circuit Court Opinion R. 468) is immaterial because neither court found that Crombie anticipated Waber.

With respect to Wildman, the Trial Court found that Wildman disclosed everything of Waber—**"everything, plus two plies of stiff rubber."** (Decision, R. 330; Finding 17, R. 336). The Circuit Court of Appeals quoted this language (R. 469), but did not express agreement. On the contrary, it found the language of Wildman not entirely clear and assumed that Wildman disclosed a process by which the tube **"could be constructed"** (R. 469). Again, there is no concurrence of opinion with respect to the disclosures of the prior art device.

The Courts below did not even concur as to the conclusions to be drawn from the prior art. The trial Court found that **"the patent in suit is either anticipated by the prior art . . . or it failed to disclose invention over such prior art"** (Finding 23, R. 337); whereas, the Circuit Court of Appeals reached the positive conclusion that **"Waber is anticipated by Wallace"** (R. 468); that **"Waber is also anticipated by Wildman"** (R. 469-470); and that **"even though it be assumed, however, that Waber is not anticipated by either Wallace or Wildman, we are still of the view that Waber's disclosure did not amount to invention over this prior art"** (R. 470). The trial Court vacillated on the question of anticipation; the Circuit

Court of Appeals was positive. Can this be deemed concurrence?

It is only in the ultimate conclusion that the patent is invalid that we find concurrence between the two opinions (Conclusion 9 a, R. 337; see also R. 471).

Further, even if the findings by the two lower courts be deemed concurrent, the rule that they are not set aside is subject to definite limitations. *Goodyear Tire & Rubber Co., Inc. et al. vs. Ray-O-Vac Company*, 321 U. S. 275, 278, cited by respondents (Res. Br. 8), refers the reader to *Williams Mfg. Co. vs. United States Shoe Machinery Corp.*, 316 U. S. 364, 367. In the *Williams* case, the rule is stated to be applicable, page 367, "where * * * there is evidence to support them."

Although the cases cited therein arose under the Interstate Commerce Commission Act, this court in *Tagg Bros. v. United States* (1930) 280 U. S. 420, 442 states that an order which rests upon an erroneous rule of law, or is based upon a finding made without evidence, or upon evidence which clearly does not support it must be set aside.

The petition sets forth at length that certain claimed features of Waber are not found in any prior art patents (Pet. 15-18, 29-32, 38 and 42 A). Since the respondents have not answered these assertions of lack of evidence, for the purposes of this petition they have admitted that there is no evidence to support the allegedly concurrent findings upon which they now rely. The rule of concurrent findings does not apply, even if they were here present.

Additionally, the findings signed by the Trial Court do not help this Court because they were prepared by counsel for respondents (R. 331, Pet. 3-4). Some appellate courts

apply the rule that such findings have little weight. *Process Engineers, Inc. vs. Container Corporation of America*, (C. C. A. 7, 1934) 70 F.(2d) 487, 489.

At Page nine (9) the respondents find fault that Representative Jenckes' remarks have no legislative effect upon the construction of the patent statute. Explanations given in Congress are always important in construing and interpreting statutes. *Wright vs. Vinton Branch* (1937) 300 U. S. 440, 459; *Addison vs. Holly Hill Fruit Products* (1944) 322 U. S. 607, 615. The remarks of a Representative in charge of a measure have the legislative effect of informing the Court what the statute means.

The report of the National Patent Planning Commission is not cited for its legislative effect, but it demonstrates that even at this late date, the Circuit Court of Appeals had no sound reason of public policy for failing to heed the expressed intention of the legislature. Congress intended the criterion to be the practical effect of the contribution on the arts. The Court of Appeals had no authority to "rewrite the statute", *Electric Storage Battery Co. vs. Shimadzu, et al.* (1939) 307 U. S. 5, 14.

Hotchkiss, et al. vs. Greenwood, et al. (1850) 11 How. (52 U. S.) 248, (Res. Br. 10, 11) is no authority for the "could have duplicated" test of invention. The quoted language (Res. Br. 10) appears in the dissenting opinion and not in the majority opinion. The instructions (pages 264-265) clearly are not subject to the "could have made or devised" interpretation. Apparently, the majority was of the opinion that the instructions were not "virtually" (Page 268), as stated by Mr. Justice Woodbury, a could have duplicated test of invention.

This Court has cited the *Hotchkiss* case a total of twenty times. (Shephard's United States Citations). Not once in those twenty times has this Court expressed the *Hotchkiss*

test of invention as a "could have duplicated" test; on the contrary, the *Hotchkiss* case has been cited as support for the "would have constructed" test advocated by the petitioner (Pet. 25) and condemned by the respondents as an effort "to persuade this Court" (Res. Br. 9).

In *Slawson vs. Grand Street R. R. Co.* (1882) 107 U. S. 649, at Page 653, this Court cited the *Hotchkiss* case to support the negative test that "it would occur to any mechanic * * *".

The respondents have misread *McClain vs. Ortmyer* (1891) 141 U. S. 419 (Res. Br. 10-12). The *McClain* case indicates that the act of invention is between "the production of something new and useful" (page 426) and "an operation of the intellect, * * * a product of intuition or of something akin to genius" (pages 426-427). Its holding is that practical contribution to the art is insufficient in the absence of "some new and important function" of an element "not performed by it in the prior patent" (page 429). The *McClain* case is inapplicable because Waber has both practical contribution and novelty.

The *McClain* case has been cited by the Supreme Court seven times but only once upon the question of practical contributions to the art. In *Dow Co. vs. Halliburton Co.* (1945) 324 U. S. 320, 330, the Court indicated that practical contributions are relevant "but * * * only in a close case where all other proof leaves the question of invention in doubt". All other proof in the instant case comprises the Wallace, Crombie and Wildman patents. The respondents, by their silence, admit that this art does not disclose three of the important contributions made by Waber -(Pet. 38; Reply 1-2 above). Thus, the respondents' principal authority supports the petition.

Moreover, this Court has cited the *McClain* case at least four times in support of the doctrine "*ut res magis valeat quam pereat*" (that the thing may prevail rather than be

destroyed),¹ and twice to support the proposition that all elements of a claim are important.² Both of these doctrines support the Petition for Certiorari.

Respondents' Part III (Res. Br. 12) is directed to the Wallace patent with an initial observation that the Appeals Court "in fact, found that Wallace disclosed all the four steps of Waber". The fallacy of this conclusion has already been established above (Reply 3-4, above). The respondents have not met the point (Pet. 30-31) that all elements of a claim must be regarded as material on the question of anticipation.

Part IV (Res. Br. 12-15) is a re-hash of the "assuming" of the Circuit Court of Appeals and the "not entirely clear" language of the Wildman patent. The accuracy of petitioner's analysis of this patent and the opinion has been discussed above (Reply 4-5, above). Further, a consideration of the opinion (R. 468-470), the Waber patent (R. 352), the Wildman patent (R. 428), and the cancelled portions of the file wrapper (Appendix B, Pet. 43-45), referred to by the petitioner to construe the "not entirely clear" language demonstrates the unsoundness of the respondents opposition argument. Respondents have not met the point (Pet. 32-33) that vague and general representations do not support the defense of anticipation.

At page thirteen (13), the respondents refer to construction in the light of the prior art and the lack of necessity to explain what is already known. If the features of Waber allegedly disclosed by Wildman were already known in the prior art, then it would have been unnecessary for the Court to refer to unclear language and assuming; it could have referred to that prior art from whence the knowledge came.

¹*Coupe vs. Royer* (1895) 155 U. S. 565, 577; *Eibel Co. vs. Paper Co.* (1923) 261 U. S. 45, 63; *Temco Co. vs. Apco Co.* (1928) 275 U. S. 319, 330; *Smith vs. Snow et al.* (1935) 294 U. S. 1, 14.

²*Cimiotti Unhairing Co. vs. American Fur Refining Co.* (1905) 198 U. S. 399, 410; *General Pictures Co. vs. Electric Co.* (1938) 304 U. S. 175, 189.

Pages sixteen (16) and seventeen (17) do not deny the fact that the prior art patents are, in truth, "paper" patents, although they do deny technical abandonment. A "paper" patent is an impractical patent which has not been put to successful use. Of what moment is the absence of an actual intent to abandon to the patent's contribution to the art if the patent never went into use?

Respondents attempt to distinguish the Supreme Court decisions cited by petitioner (Pet. 34-35) on the ground that they involve "*the patent in suit in that case*". In any case, the question is one of the broadness of construction to which the patent is entitled. Obviously a "paper" patent should have as narrow a range of anticipation equivalency as of infringement equivalency. The opinions cited by the petitioner hold that a patent which successfully accomplishes the desired end is not anticipated by one which fails to do it (Pet. 35-37).

Respondents' observation that the petitioner "does not even venture to draw any deduction from the cited cases" (Res. Br. 16) is rebutted by the deduction that a "paper" patent is entitled to but a narrow construction at all times, whether it be the patent in suit or it be a prior art patent. In each case its affect and teaching upon the art is negligible.

At pages seventeen (17) to nineteen (19), the respondents find fault that the petitioner has not cited any supporting decisions. This Court throughout the years has decided patentability upon established objective tests. Petitioner's reasons for not citing decisions are two-fold. First, the presence and application of objective tests is something which properly should be delayed until it is learned whether or not Certiorari will be allowed. This, because the presence or absence affects not one whit the petitioner's right to the Writ. Secondly, both the Court

and the respondents are familiar with the decisions involving objective tests of invention.

For information solely, that the Court and the respondents may be advised as to some of the cases upon which petitioner will rely if the petition be granted, the petitioner cites the following list of authorities as enunciating established objective tests of invention: *Goodyear Tire & Rubber Co. vs. Ray-O-Vac Co.* (1944) 321 U. S. 275, 276, 278, 279; *Smith vs. Snow* (1935) 294 U. S. 1; *Minerals Separation, Ltd. vs. Hyde* (1916) 242 U. S. 261, 270; *Diamond Rubber Co. vs. Consolidated Tire Co.* (1911) 220 U. S. 428, 440, 441; *Expanded Metal Company vs. Bradford* (1909) 214 U. S. 366, 381; *Carnegie Steel Co. vs. Cambria Iron Co.* (1902) 185 U. S. 403, 445; *Krementz vs. S. Cottle Co.* (1893) 148 U. S. 556, 560; *Barbed Wire Patent* (1892) 143 U. S. 275, 283; *Loom Company vs. Higgins* (1881) 15 Otto (105 U. S.) 580, 591; *Smith vs. Goodyear Vulcanite Co.* (1876) 3 Otto (93 U. S.) 486, 494; *Rubber Company vs. Goodyear* (1869) 9 Wall. (76 U. S.) 788, 793; *Steiner Sales Co. vs. Schwartz Sales Co.* (C. C. A. 10, 1938) 98 F. (2d) 999, 1003; *McKee, et al, vs. Graton & Knight Co.* (C. C. A. 4, 1937) 87 F. (2d) 262, 264; *Hoeltke vs. C. M. Kemp Mfg. Co.* (C. C. A. 4, 1935) 80 F. (2d) 912, 919; *Trico Products Corporation vs. Apco-Mossberg Corp.* (C. C. A. 1, 1930) 45 F. (2d) 594, 598; *Frick Co. vs. Lindsay* (C. C. A. 4, 1928) 27 F. (2d) 59, 61; *Inland Mfg. Co. vs. American Wood Rim Co.*, (C. C. A. 6, 1926) 14 F (2d) 657, 659; *Kurtz, et al vs. Belle Hat Lining Co., Inc.* (C. C. A. 2, 1922) 280 Fed. 277, 281.

The respondents must well be aware that the facts recited in the Petition, pages 37-42, have, for more than 75 years, strengthened the normal presumption of validity of Letters Patent issued after an examination by the Patent Office; by their silence, they admit the presence of the objective facts referred to in the Petition.

One exception, and one only, appears; that is that the Respondents observed that "the Court of Appeals found that there is no commercial success here (R. 470)" (Res. Br. 18). The Court found that "During the peak year of 1940, something like 100,000 Waber tubes were sold"; and "True, the record discloses some large business concerns which used plaintiff's tubes and found them satisfactory" (R. 470). **This is commercial success.** But in view of sales of 35 to 40 million ordinary inner tubes sold annually, the Court merely viewed it as "far less impressive" than asserted by the Petitioner. Had the sales of prior art *puncture sealing tubes* been several million, its observation would have some merit. But its finding of sales of 100,000, if properly compared with a record showing no sales of prior art tubes, is in truth a finding of vast commercial success. The correct comparison is 100,000 to zero, not 100,000 to several million. A comparison with an improper control teaches the observer nothing.

In his supporting brief, the Petitioner spelled out the failure of the Circuit Court of Appeals to select the proper standard of comparison (Pet. 19). The Respondents remain silent upon this issue.

CONCLUSION.

In conclusion, the petitioner submits:

- 1) that respondents have failed to meet any of the issues raised by the petitioner, or any of the points relied upon by him;
- 2) that the respondents, by silence, admit the fact that Waber made three contributions to the art;
- 3) that the respondents' accusations of inaccuracy and omissions are unwarranted;
- 4) that the opinions and findings by the courts below have no controlling effect upon this Court in deciding

the question of patentability, (a) because the "prior art" evidence is wholly documentary, (b) because the opinions and findings are not concurrent on questions of fact, (c) because the opinion of the Circuit Court of Appeals is inconsistent *inter se*, (d) because the findings of the Trial Court were prepared by counsel for respondents, and (e) because there is no evidence to support the conclusions of anticipation or lack of invention;

5) that a patentee should have the benefit of the unlikelihood of a conflict of decisions rule to at least the same extent as an infringer;

6) that this Court should render an opinion on the revolutionary "could have duplicated" test of invention adopted by the Circuit Court of Appeals;

7) that this Court should render an opinion on the effect of unsuccessful or "paper" patents as prior art;

8) that this Court should render an opinion as to whether a patent may be anticipated by prior art patents which do not disclose several **claimed features** of the patent in suit; and

9) that this Court should render an opinion as to whether patentability, assuming novelty, should be determined subjectively or whether it should be determined objectively by its practical contributions to the art.

Petitioner therefore renews his earnest request that a writ of *certiorari* be granted for the reasons specified in the petition.

Respectfully submitted,

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